

REMARKS

Previously presented claims 37-43 are the only active claims pending in this application. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, each with an indication at its first line showing the claim's current status.

I. Request for Acknowledgement of Foreign Priority

Applicants filed the present application on November 4, 2003 with a claim of foreign priority under 35 U.S.C. §119(a)–(d). Applicants filed certified copies of all the priority documents on January 30, 2006.

Applicants respectfully request acknowledgment of their claim of foreign priority and acknowledgment of receipt of the priority documents.

II. Rejections Based on Prior Art

The Office Action rejects claims 37-43 under 35 U.S.C. §103(a) as being unpatentable over European Patent Application No. EP 1 407 893 A2 ("Janosky") in view of U.S. Patent No. 6,332,679 ("Higuma").

Applicants respectfully traverse the rejection as not supported by the references relied upon.

Base claim 37 is a method claim, having the steps of:

- providing a sheet, the sheet having a base, a thermoplastic resin layer, and an image recording layer on the thermoplastic layer,
- providing a contact member having a surface quality,
- heating the sheet,
- forming the surface quality on the sheet, including the interface between the thermoplastic layer and the image recording layer, and
- cooling the sheet while in contact with the surface member.

The primary reference, Janosky, discloses printing on an image recording layer 14, laminating a thermoplastic protective layer 20 over the image recording

layer 14, to protect the image, heating the protective layer 20, then embossing a surface quality on that protective layer 20.

Janosky teaches placing the thermoplastic layer on top of an image, to protect the image.

Reading Janosky in its entirety, one of ordinary skill in the art would conclude the thermoplastic layer must be placed over the image recording layer.

Janosky therefore discloses nothing within the meaning of the claim 37 limitation of providing a sheet having a base, a thermoplastic layer on the base, and image recording layer on the thermoplastic layer.

Further, Janosky discloses nothing within meaning of the claim 37 limitation of forming the surface quality at the interface between the thermoplastic layer and the image recording layer above it.

The secondary reference, Higuma, discloses a porous transfer layer, on top of the image recording layer, having thermoplastic particles in suspension, functioning to transfer ink to the underlying image recording layer.

Higuma is therefore, at best, inferior to Janosky, as a reference with respect to Applicant's claim 37.

Applicants respectfully submit Higuma and Janosky show the scope and content of the prior art to be: a thermoplastic layer is overlaid on an image layer, for protective purpose, and a surface quality may be pressed onto the protective layer. Therefore, on a thorough and objective reading of the entirety of Janosky and Higuma, the differences between Applicants' claim 37 and the prior art are least all of the following:

- providing a sheet, the sheet having a base, a thermoplastic resin layer, and an image recording layer on the thermoplastic layer, and
- forming the surface quality on the sheet, including the interface between the thermoplastic layer and the image recording layer

Applicants respectfully submit that modifying, combining, and rearranging the collective teachings of Janosky and Higuma is beyond, far beyond, a predictable use of prior art elements. There is nothing found in Janosky and/or Higuma indicative of

Applicants' claim 37 being a "predictable use." The only "predictable use" of a thermoplastic layer supported by these references is a combination protective and surface quality use, on top of the image recording layer.

Applicants respectfully submit, in further support of the non-obviousness of claim 37, the fact that Janosky teaches away from placing the thermoplastic layer under the image recording layer.

Applicants further submit that, in view of Janosky's repeated and consistent teaching of the thermoplastic layer on top of the image recording layer for protection, the necessary modifications, combinations and rearrangements of Janosky and Higuma to achieve claim 37 are not reasonably arguable as being "obvious to try."

Applicants further submit, respectfully, the rejection appears inconsistent with the Examiner's stated position in the Final Office Action (September 25, 2006), rejecting apparatus claims 1-6, now canceled, in the parent of this Request for Continuing Examination (RCE) application. The Examiner's position, with respect to the apparatus claims, was that although Janosky places the thermoplastic layer over the image recording layer, opposite Applicants' invention, Janosky's image recording layer supposedly has a surface quality and:

[Claim 1] is an apparatus claim ... not a method claim comprising the step of transferring an image quality to the surface of the image recording layer ... [and] the final product is the same as the present [claimed apparatus] invention.

Final Office Action, September 25, 2006, at page 5.

The present claims 37-43 are method claims, reciting the claimed steps lacking in Janosky. Applicants respectfully request clarification of the apparent inconsistency.

Applicants further submit the Office Action does not show consideration for the claim 37 limitation of transferring the surface quality to the interface between the thermoplastic layer and the claimed overlaying image recording layer. The Examiner's list of claim limitations at pages 2-3 of the Office Action does not list this limitation.

For purposes of expediting this application, Applicants have amended claim 37 to more clearly state the interface between the thermoplastic layer and

the image recording layer disposed above it, and to more clearly recite the forming of the surface quality on the interface.

Claims 38-43 are dependent on claim 37 and, therefore, are patentable over the combination of Janosky and Higuma for at least the reasons presented for claim 37.

Further, with respect to claim 43, Applicants further request the Examiner to identify the Examiner's position as to where the limitations of different surface qualities at different belt regions are disclosed by Janosky and Higuma.

Applicants respectfully request the Examiner that if the claims are not deemed allowable that a non-Final Office Action be mailed, to give Applicants a proper and fair opportunity to respond to the Examiner's position.

CONCLUSION

Applicants respectfully request, for the foregoing reasons, that the application be reconsidered, that at least claims 37-43 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is respectfully requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

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